



PATENT  
450108-4484

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Katsuakira Moriwake et al.

Serial No. : 09/068,866

For : EDITING SYSTEM, EDITING METHOD, CLIP  
MANAGEMENT APPARATUS, AND CLIP  
MANAGEMENT METHOD

Filed : October 23, 1998

Examiner : Thomas J. Joseph

Art Unit : 2173

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William S. Frommer, Reg. No. 25,506

\_\_\_\_\_  
Name of Applicant, Assignee or Registered Representative

  
\_\_\_\_\_  
Signature

March 21, 2002

\_\_\_\_\_  
Date of Signature

**PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is a Petition to withdraw the "finality" of the December 10, 2001 Office Action.



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### REMARKS

#### RELIEF REQUESTED

It is respectfully requested that the finality of the December 10, 2001 Office Action be withdrawn. While this is believed to be a "no-fee" petition, any fee for this request or any overpayment in the fee for this request may be charged or credited to Deposit Account No. 50-0320.

#### FACTS AND ARGUMENT

The December 10, 2001 final Office Action was issued after Applicant filed a November 16, 2001 Amendment in response to a July 16, 2001 Office Action. The July 2001 Office Action relied on McGrath in a Section 103 rejection to reject all of the claims. The Amendment urged that McGrath be removed as a reference because the present application has an effective filing date which antedates the U.S. filing date of McGrath. The December 10, 2001 final Office Action employs Klinger in combination with Langford in a new Section 103 rejection. Evidently, McGrath was removed.

The November 2001 Amendment cancelled claims 1-89, 91, 94-121 and 133 (which were rejected in the July 2001 Office Action under 35 U.S.C. 112, 2<sup>nd</sup> paragraph), and incorporated recitation(s) from those cancelled into newly added claims 143-161, presented in a form consistent with U.S. practice; and, therefore, both before and after the November 2001 Amendment, an editing system and method for producing a resultant clip from a plurality of clips were under examination. Thus, the subject matter under examination after the November 2001 Amendment was not substantially different than the subject matter under examination before the November 2001 Amendment.

Accordingly, the November 2001 Amendment did not necessitate the new rejection presented in the December 2001 Office Action.

Moreover, inasmuch as Applicants had asserted a claim under 35 U.S.C. 119 to the Japanese priority date of September 20, 1996, which antedates the effective filing date of McGrath, it did not come as a surprise to the Examiner that an English translation of the Japanese priority application was submitted. The withdrawal of McGrath and the need to find other prior art to meet the claimed invention was not attributed to any action by Applicants. Indeed, as just mentioned, the Examiner should have expected that McGrath would have to be replaced.

Therefore, the finality of the December 10, 2001 Office Action is improper. The Examiner's rejection of substantially the same subject matter that has been claimed all along, based on a new set of references, cannot for the first time be made in a final Office Action.

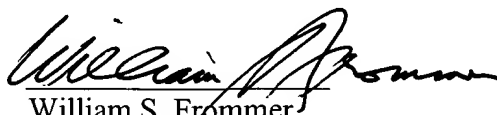
#### CONCLUSION

The finality of the December 10, 2001 Office Action is improper. The December 10, 2001 Office Action contains a new rejection that cannot be made for the first time in a final Office Action. The finality of the December 10, 2001 Office Action should be withdrawn; and, such relief is respectfully requested.

Respectfully submitted,

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